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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/231,714	01/15/1999	PATRICK E. PATTERSON	09939/003001	2717

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EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/231,714	PATTERSON, PATRICK E.	
	Examiner	Art Unit	
	Paul H Kang	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,751,670 B1.

Claims 1-31 of patent no. 6,751,670 to Patterson contains every element of claims 1-27 of the instant application and as such anticipate claims 1-27 of the instant application.

“A later patent claim is not patentably distinct from an earlier patent claim if the later

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claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell, US Pat. No. 6,067,526 in view of Gupta et al., US Pat. No. 6,484,156 B1, and further in view of Venkatraman et al., US Pat. No. 6,304,897.

5. As to claims 1, 2, 4, 20, 21, 22 and 24, Powell teaches the invention substantially as claimed. Powell teaches a computer program and method of delivering electronic content, the computer program and method comprising:

providing instructions, including web page form instructions displayed on the browser upon selection of a link, that cause a first computer to transmit the first computer's or the user's e-mail address to a second computer in response to a request for a first information (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46); and

processing information at a second computer and selecting electronic content for transmission and transmitting the selected electronic content to an email address (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46).

However, Powell does not explicitly teach dynamically transmitting the information to the second computer, wherein there is no manual user input of user information. Instead, Powell prompts the user to enter the e-mail and other information prior to transmitting the request (Powell, col. 13, lines 5-46).

In the same field of endeavor, Gupta teaches a system for dynamically transmitting user information to a remote server. Gupta transmits user information dynamically upon user instruction to "Add New Annotation". (see Gupta, col. 13, line 6-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated dynamic transmission of information, as taught by Gupta, into the system of Powell for the purpose of increasing the efficiency and user friendliness of the data transfer.

Further, Powell-Gupta does not explicitly teach transmitting notification upon an attempt to access the requested data, wherein the instructions are executable instructions and collect the notification information and selectively grants access to the requested data until the notification information is transmitted. In the same field of endeavor, Venkatraman teaches a system and

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method for processing an email message that includes a representation of an envelope wherein the instructions are executable instructions and collect the notification information and selectively grants access to the requested data until the notification information is transmitted (Venkatraman, col. 5, line 12 – col. 6, line 46 and col. 7, lines 47-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the notification system as taught by Venkatraman into the system of Powell-Gupta for the purpose of controlling user access to transmitted data.

6. As to claim 3, Powell-Gupta-Venkatraman teach providing instructions comprising HTML instructions (Powell, col. 9, line 46 – col. 10, line 51 and col. 13, lines 5-46).

7. As to claim 5, Powell-Gupta-Venkatraman teach the instructions that cause the first computer to collect information comprise instructions that query the first computer for information (Gupta, see Gupta, col. 13, line 6-37).

8. As to claim 6, Powell-Gupta-Venkatraman teach the instructions that cause the first computer to collect information comprise instructions that receive user input (Powell, col. 13, lines 5-46).

9. As to claims 7 and 8, Powell-Gupta-Venkatraman teach providing demographic and system information (Powell, col. 10, lines 5-34).

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10. As to claims 9, Powell-Gupta-Venkatraman teach processing the information comprising executing a script (Gupta, col. 9, lines 56-67).

11. As to claims 10, Powell-Gupta-Venkatraman teach the invention substantially as claimed. However, Powell-Gupta-Venkatraman does not explicitly teach processing the information comprising executing a CGI script on the first computer. As applied regarding claim 9, Powell-Gupta-Venkatraman does teach the use of a script (Gupta, col. 9, lines 56-67).

Official Notice (MPEP 2144.03) is taken that implementation of CGI scripts in web based communications was well known at the time of the invention. Montulli, US Pat. No. 6,134,592, cited as relevant but not relied upon (paper no. 12), exemplifies the knowledge in the art at the time of the invention regarding the use of CGI scripts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the use of CGI scripts into the system of Powell-Gupta-Venkatraman for the purpose of using a widely accepted and robust programming code.

12. As to claim 11, Powell-Gupta-Venkatraman teach the instructions remain at the first computer (Powell, col. 10, lines 5-34).

13. As to claim 12-16, Powell-Gupta-Venkatraman teach a system wherein the electronic content comprises text, graphics, audio, video or executable instructions (Powell, col. 9, line 7 – col. 10, line 51 and col. 13, line 5 – col.14, line 33).

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14. As to claims 17-19, Powell-Gupta-Venkatraman teach a system wherein the information comprises selecting electronic content based on the transmitted information, and further comprising identification of the instructions and the computer that transmitted the information (Gupta, col. 13, line 6 – col. 14, line 38).

15. As to claim 23, Powell-Gupta-Venkatraman teach a system wherein the instructions that cause the processor to select electronic content comprise instructions that cause the processor to use a table that indicates electronic content corresponding to data included in the received information (Powell, col. 16, lines 22-62).

16. As to claims 25-27, Powell-Gupta-Venkatraman teach transmitting a notification information when the requested data is subsequently accessed by third computer (Venkatraman, col. 5, line 12 – col. 6, line 46 and col. 7, lines 47-67).

17. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


PAUL H. KANG
PRIMARY PATENT EXAMINER